REMARKS

Claims 1-3, 12-17, 19, and 21-22 are pending in this application. By this Response, claims 12, 15, 16, 21and 22 are amended. Claim 12 is amended to remove the means-plus-function language and to include the features of a processor and a memory coupled to the processor, the memory comprising instructions which may be executed by the processor. Support for the addition of the processor and memory features to claim 12 may be found at least in Figure 1 and the corresponding text of the present specification. Claim 21 is amended to be consistent with the amendments to claim 12 and to remove the recitation of means-plus-function. Claims 15, 15, and 22 are amended to recite a "computer-recordable" medium having computer executable instructions "recorded thereon" and to remove the recitation of means-plus-function language. No new matter has been added by any of the amendments to the claims. In addition the specification is amended to update serial number information for related applications. Reconsideration of the claims is respectfully requested in view of the above amendments and the following remarks.

I.   Objection to the Specification

The Office Action objects to the specification requiring that the serial numbers for the related applications be provided. By this Response, the specification is amended to include the appropriate serial numbers. Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

II.   Rejection under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 12, 15, 21, and 22 under 35 U.S.C. § 112, second paragraph stating that the various "means" set forth in these claims need to be identified in the specification. By this Response, claims 12, 15, 21, and 22 are amended to remove the means-plus-function features. The removal of the means-plus-function language from the claims is not an admission of any lacking on the part of the specification. To the

contrary, the amendments are made based on a desire to not invoke 35 U.S.C. § 112, sixth paragraph and instead recite specific structural elements of a processor and a memory as well as instructions, as appropriate. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

III.   Rejection under 35 U.S.C. § 101

The Office Action rejects claims 15, 16 and 22 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. By this Response, claims 15, 16 and 22 are amended to recite a "computer-recordable" medium having computer-executable instructions "recorded thereon." Thus, claims 15, 16, and 22 no longer encompass carrier wave embodiments. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 15, 16, and 22 under 35 U.S.C. § 101.

IV.   Rejection under 35 U.S.C. §102 Based on Benantar

The Office Action rejects claims 1, 2, 12, 13, 15 and 16 under 35 U.S.C. § 102(b) as allegedly being anticipated by Benantar (U.S. Patent No.5,787,427). This rejection is respectfully traversed.

Claim 1 of the present application, which is representative of the other rejected independent claims 12 and 15 with regard to similarly recited subject matter, reads as follows:

> 1.   A method, in a data processing system, for handling personally identifiable information, said method comprising:
>   providing, in a computer, a first set of object classes representing active entities in an information-handling process, wherein a limited number of privacy-related actions represent operations performed on data and wherein each of the active entities is a human being or legal entity;
>   providing, in said computer, a second set of object classes representing data and rules in said information-handling process, wherein at least one object class has said rules associated with said data, and wherein said data represents said personally identifiable information; and
>   processing transactions, in the data processing system, involving said personally identifiable information, using said computer and said first

and second set of object classes, so as to enforce a privacy policy, associated with the personally identifiable information and defined by said rules, against one or more active entities represented by said first set of object classes, wherein each of the one or more active entities represented by said first set of object classes is a human being or legal entity, wherein:

<u>a first active entity represented by a first object class in said first set of object classes is a first data user that requests said personally identifiable information from a data subject that is a second active entity represented by a second object class in said first set of object classes,</u>

<u>said data subject is an active entity that is personally identifiable by said personally identifiable information;</u>

<u>a third active entity represented by a third object class in said first set of object classes is a second data user that requests personally identifiable information from said first data user, and</u>

<u>said rules define if and how said personally identifiable information may be provided, by said first data user, to said second data user.</u>
(emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Benantar does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, Benantar does not teach the features of claim 1 emphasized above, or the similar features found in the other rejected independent claims.

It should be noted that claim 1 of the present application recites three specific active entities: (1) a first data user that requests personally identifiable information from (2) a data subject, and (3) a second data user that requests the personally identifiable information for the data subject (2) from the first data user (1). The rules define if and how the personally identifiable information (about the data subject (2)) may be provided, by the first data user (1), to the second data user (3). Thus, the rules in the present

invention define if and how one party may send information to a second party, the information being descriptive of a third party. Benantar does not provide any such features.

Benantar describes an information handling system in which objects are grouped so that they can share common control access policies. Benantar is concerned with the large storage requirements of Access Control Lists (ACLs) and alleviates the problems of having to have a lot of storage or memory consumed by ACLs by grouping objects that can use the same access policies on a particular object or set of objects. However the control access policies merely specify the types of actions, or methods, that the particular objects can themselves perform on the object in question, e.g., read, write, execute, use, administer, or control (see column 6, lines 54-67).

In particular Benantar has improved upon the traditional access matrix in which authorization policies are specified by identifying subjects in rows of the matrix and rights in the columns of the matrix with the corresponding authorization policies being specified in the intersection of the row and column (see column 3, line 22 to column 4, line 47). The improvement offered by Benantar is to group subjects and then use the groups, rather than the individual subjects, in the access matrix (see Tables 4 and 5 of Benantar). However, in all cases, the resulting authorization policy in the access matrix of Benantar is the same as in the traditional access matrix, i.e. the authorization policy specifies what access the subject has to the object in question.

To the contrary, the rules in claim 1 are not limited to what access the first data user has to the data subject or what access the second data user has to the data subject. Rather, the rules specify if and how the data subject may be provided <u>by the first data user to the second data user</u>. The access mechanisms of Benantar do not cover such functionality. Rather, with Benantar, the access matrix merely specifies what operations the first data user may perform on the data subject, and separately specifies what operations the second data user may perform on the data subject. The access matrix in Benantar does not specify if and how the first data user may send the data subject to the second data user in response to the second data user requesting the data subject from the first data user.

In other words, Benantar provides mechanisms for controlling access by the data users to the data subject in the manner depicted in Figure A below:
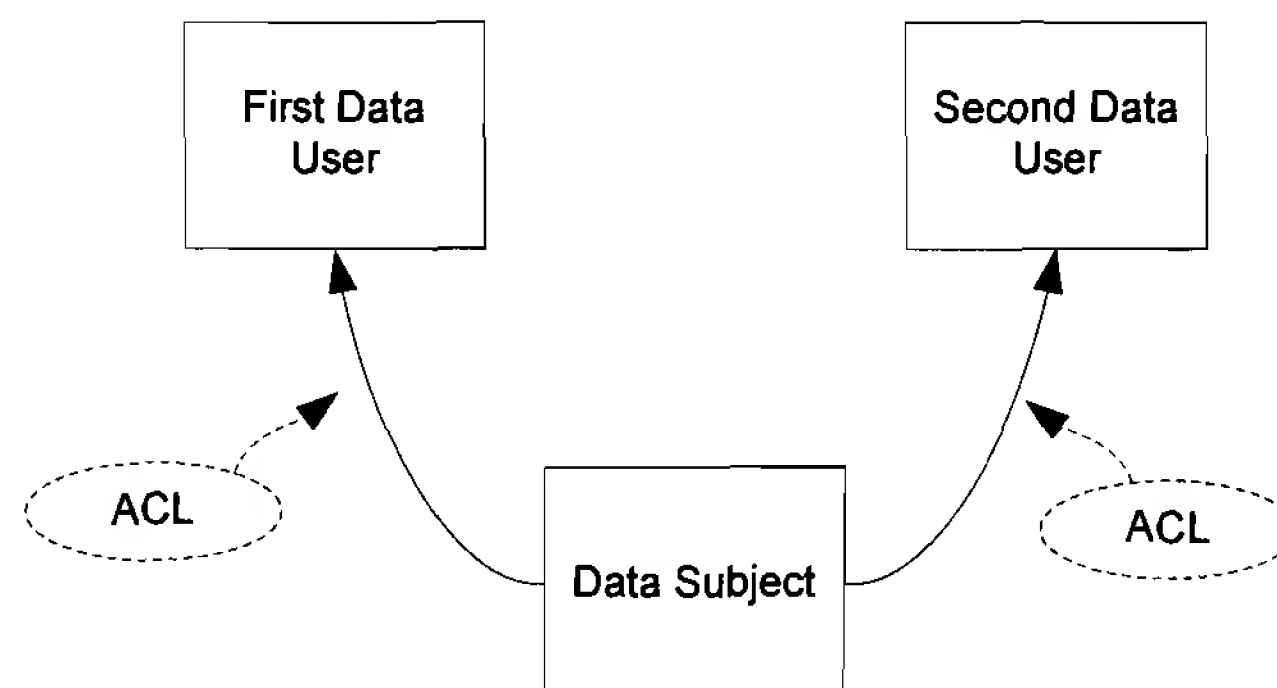

FIGURE A

As can be seen from Figure A, the ACLs or access matrix of Benantar only addresses each individual data user, or "subject" in Benantar, access to the data subject. To the contrary, the rules recited in claim 1 of the present application provide a mechanism for controlling access by the data users to the data subject in the manner depicted in Figure B below:
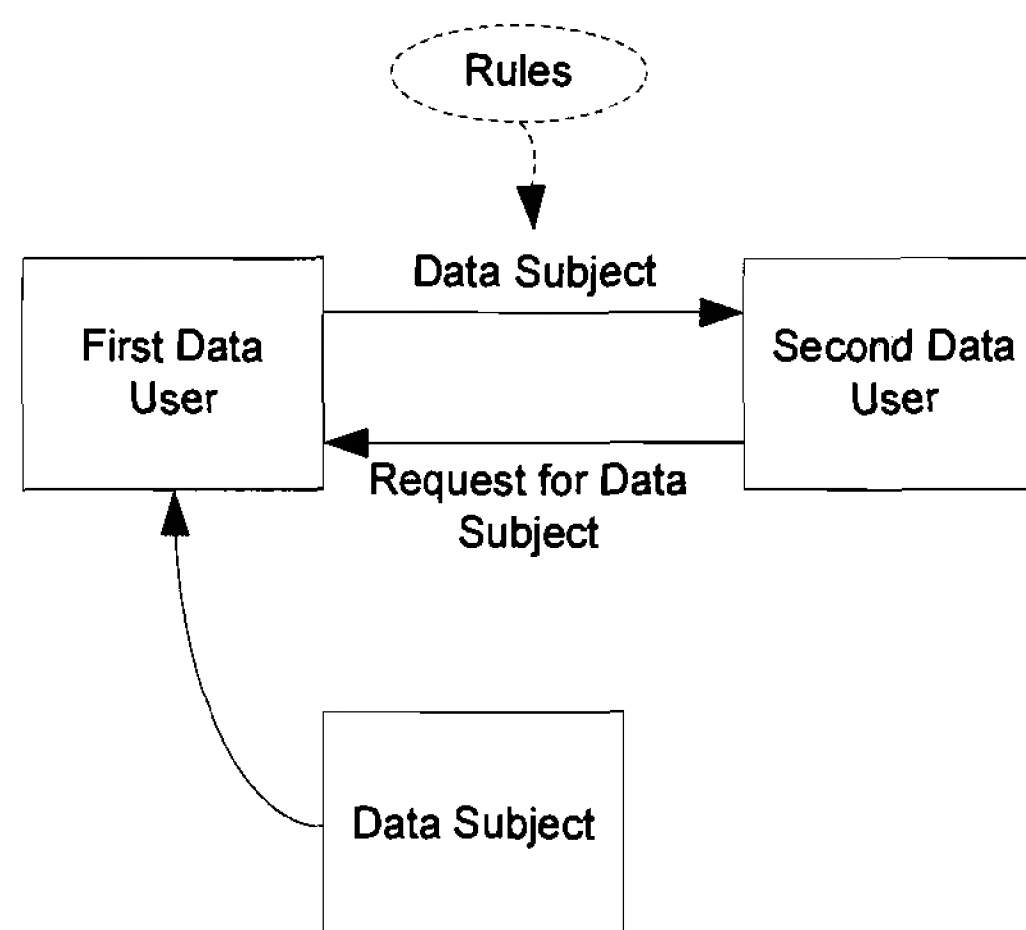

FIGURE B

As can be seen from Figure B, the rules of the invention recited in claim 1 control the transfer of the data subject from the first data user to the second data user. Benantar is not even concerned with such transfers of information, let alone provides any mechanism for controlling such transfers of information.

Thus, in view of the above, Applicants respectfully submit that Benantar does not teach each and every feature of independent claim 1 as is required under 35 U.S.C. § 102(b). Similarly, Benantar does not teach each and every feature of independent claims 12 and 15 for similar reasons. At least by virtue of their dependency on claims 1, 12, and 15, respectively, Benantar does not teach each and every feature of dependent claims 2, 13, and 16. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 2, 12, 13, 15 and 16 under 35 U.S.C. § 102(b).

V.   Rejection under 35 U.S.C. §103(a) Based on Benantar and Tolopka

The Office Action rejects claims 3, 14, and 17 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Benantar in view of Tolopka (U.S. Patent No. 6,044,349). This rejection is respectfully traversed for at least the same reasons as set forth above with regard to the 35 U.S.C. § 102(b) rejection based on Benantar. That is, Benantar does not teach or even suggest the features discussed above. Moreover, Tolopka does not provide any teaching or suggestion to alleviate the deficiencies of Benantar noted above.

Tolopka is directed to a portable storage medium to store data and provide access to information from an information dissemination system (IDS). The storage medium can store one or more location/key pairs. Each of the location/key pairs designates a particular IDS location as well as an access key to the particular IDS location. The storage medium can also store a plurality of information units. The information units are categorized into levels of information categories with at least one information category per level and at least one information unit per information category. Levels of information categories can be individually accessed and categories of information units within levels can be selectively downloaded.

Thus, Tolopka is only concerned with what access a particular information seeking system has to an IDS, and controls this access based on a key providing on a smart card. The key and smart card in Tolopka operate in a similar manner as the ACLs of Benantar in that they only control access by that particular subject, or information seeking system, to a particular object. They do not have anything to do with controlling

how the information seeking system may then send that information to another information seeking system.

Tolopka is cited by the Office Action as allegedly teaching objects that may represent paper-filled forms. Even if Tolopka were to teach or suggest such features, Tolopka does not provide any teaching or suggestion regarding rules that define if and how the personally identifiable information (about a data subject) may be provided, by a first data user, to a second data user, as recited in independent claims 1, 12, and 15, from which claims 3, 14, and 17 depend. Thus, any alleged combination of Tolopka and Benantar, even if such a combination were possible and one were somehow motivated to make such a combination of teachings, would not result in the features of independent claims 1, 12, and 15, or their dependent claims 3, 14, and 17, being taught or suggested.

In view of the above, Applicants respectfully submit that the alleged combination of Benantar and Tolopka does not teach or suggest the features of claims 3, 14, and 17. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3, 14, and 17 under 35 U.S.C. § 103(a).

VI.   Rejection under 35 U.S.C. §103(a) Based on Benantar and Gifford

The Office Action rejects claims 19, 21, and 22 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Benantar in view of Gifford (U.S. Patent No. 5,614,927). This rejection is respectfully traversed for at least the same reasons as set forth above with regard to the 35 U.S.C. § 102(b) rejection based on Benantar. That is, Benantar does not teach or even suggest the features discussed above. Moreover, Gifford does not provide any teaching or suggestion to alleviate the deficiencies of Benantar noted above.

Gifford is directed to a system and method for protecting a database against deduction of confidential attribute values therein. A memory is provided for storing the database and a processor is provided for processing the database. Using the processor, the database is electronically partitioned into public attributes, containing nonconfidential attribute values, and private attributes, containing private attribute values. The processor is then used to electronically process the private attribute values to reduce any high correlation between public attribute values and private attribute values.

Gifford is cited by the Office Action as allegedly teaching depersonalization of objects. Even if Gifford were to teach or suggest such features, Gifford does not provide any teaching or suggestion regarding a mechanism, or even rules, for governing if and how a first data user may send a data subject to a second data user. Thus, any alleged combination of Gifford and Benantar, even if such a combination were possible and one were somehow motivated to make such a combination of teachings, would not result in the features of independent claims 1, 12, and 15, or their dependent claims 19, 21, and 22, being taught or suggested.
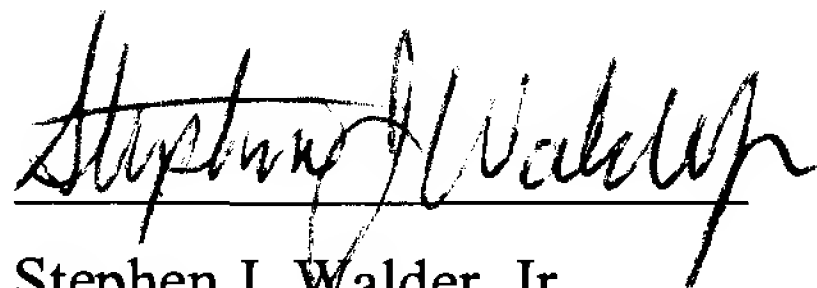
In view of the above, Applicants respectfully submit that the alleged combination of Benantar and Gifford does not teach or suggest the features of claims 19, 21, and 22. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 19, 21, and 22 under 35 U.S.C. § 103(a).

VII.   Conclusion

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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